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Applicant: Ruben et al.
Appl. No.: 09/345,373
Filing Date: July 1, 1999
Title: KERATINOCYTE GROWTH FACTOR-2
Attorney Docket No.: PF155C1
Pub. No.: US 2003/0077695 A1
Pub. Date: April 24, 2003

OFFICE OF PETITIONS

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on June 20, 2003 for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication omits some of the continuity data and there is a typographical error in dependent claim 32. Applicant argues that the mistake is material because the missing priority data affects the use of the published application as prior art under 35 U.S.C. § 102(e), as a member of the public would be unable to determine the correct effective date of the publication as a reference and that the scope of claim 32 can not be determined from the publication.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹ The instant request does not identify a material mistake in the publication made by the Office:

The error in the continuity claim is an Office mistake, but it is not a material mistake as required by 37 CFR 1.221(b). The improper priority claim is not a material mistake because it does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. The error in dependent claim 32 is also an Office mistake as "Leu (152) Phe" is misspelled as -Leu (52) Phe-, but it is not a material mistake as required by 37 CFR 1.221(b). The error in the claim is not a material mistake, as it is a minor typographical error, the amino acid was correctly written in the preceding dependent claim, the claim has been canceled and additionally the amino acid was correctly printed in the child application (10/075,446) as US 2003/0129687 A1. The specification was accurately published, thus one can read and understand the content of the application. The error also does not affect the use of the patent application publication as a prior art reference, because the earliest priority date is correctly published. While some of the related continuity data is missing, anyone looking to determine the effective date of the publication as a reference would

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

have to order the provisional application files and would be reviewing PALM. To help avoid errors in the continuity data in the future, applicant's representative should request a corrected filing receipt using the facsimile number (703-746-9195) on the Filing Receipt.

The applicant is advised that a “request for republication of an application previously published” may be filed under 37 CFR 1.221(a). Such a request for republication “must include a copy of the application in compliance with the Office’s electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i).” If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(b), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: 703-305-8568

The application is being forwarded to the Files Repository.

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).


Mark Polutta
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt